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| 10/039,570 | 10/26/2001 | Tyler Tierney | 27734/92540 | 4128 |

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| EXAMINER |
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VANAMAN, FRANK BENNETT

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| ART UNIT | PAPER NUMBER |
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3618

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04/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/039,570 | Applicant(s) TIERNEY ET AL. | |
| | Examiner Frank B. Vanaman | Art Unit 3618 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17 and 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Application

1. Applicant's amendment, filed Jan 11, 2008, has been entered in the application. Claims 1-14, 17 and 19-26 are pending, with claims 15, 16 and 18 having been canceled.

Claim Objections

2. Claims 10 and 12 are objected to because of the following informalities: In each of claims 10 and 12, at lines 1-2, the phrase "the truck each truck assembly" is informal. In this case, it appears as though applicant inadvertently left in "the truck" when amending the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14, 17 and 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rue (US 4,093,252) in view of Kimmell (US 4,071,256). Rue teaches an in-line, two-wheeled skateboard having a substantially planar board (20 with first and second ends (see figure 1), first and second truck assemblies (21) one each truck assembly being associated with one each of the first and second ends (note figure 3), a wheel support assembly (22) pivotally associated with the board, each wheel support being pivotal about an axis orthogonal to the board face (see figure 4), each wheel support having at least wheel positioning structure (e.g. apertures at the distal end of 22), which respectively carry the wheel axles, the wheel axles mounting first and second in-line wheels (23) which are rotatably mounted with respect to the remaining assembly (see col. 1, lines 67-68) through the wheel positioning structure, wherein the wheels may occupy a centered configuration (figure 2), the wheel supports being raked at a non-orthogonal angle (see figure 3), each truck including a base portion (25) secured (26) to the board. The reference to Rue fails to explicitly teach the use of an elastomeric

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spring element for maintaining the wheels in a centered condition, and fails to teach the mounting structure for accommodating the elastomeric spring. Kimmell teaches that it is well known to provide a centering device for the wheel assemblies of a skateboard so as to allow the wheels to maintain a 'usually centered' condition absent the application of force off-center by a rider, which constitutes a generally cylindrical elastomeric spring (120, figure 6) which operates to resist the pivoting of a wheel assembly including an axle (e.g., 68) from a centered equilibrium position, the forward and rearward wheel assemblies being raked in opposite directions (see figure 2), the arrangement including a housing (60, 74, 134) associated with a base (56, 57), a lug shaft (90, 92, 94, 106) engaging the base (e.g., through 76 and/or 86) and housing (at least housing portion 134), the lug shaft rigidly secured to the base when tightened, the housing (at least portion 134) being pivotably 'associated' with the lug shaft (at engagement of 94, 82, 136, 134), the lug shaft (e.g., portion 106) including an outwardly extending lug portion (116/112) forming a spline which engages with a mating keyway portion (124, 126) on the spring, each truck including an outwardly positioned hollow cylinder (78), 'associated with' the housing, the cylinder having a pair of cylinder splines (86, 88) and wherein the spring further defines at least a pair of keyways (128, 130) which receive the splines, the spring being received within the housing (e.g., portions 74, 134), the truck assemblies further including at least one end cap (142, 96) which engages with the lug shaft and retains the spring, the truck assemblies further including at least one retaining clip (104, 140) releasably associated with the end cap element. It would have been obvious to one of ordinary skill in the art at the time of the invention to use an elastomeric cylindrical spring and associated mounting structure: holding splines, lug shaft, cap, etc. as taught by Kimmell in association with each pivotal wheel mount taught by Rue, for the purpose of ensuring that a centered configuration of the wheel mounts is returned to after a user executes a turn, which beneficially allows a user to easily execute straight-line running (i.e., due to the restoring force of the spring) with minimal care.

Response to Comments

5. Applicant's comments, filed with the amendment, have been carefully considered. As regards applicant's remarks directed to the application of Pinchock and Kimmell separately as single references under 35 USC §102 and §103, the examiner agrees that neither reference can anticipate the claims as now written, and that neither reference can render the claims obvious while applied as a single reference. Note, however, the reference to Rue, long of record, and cited by applicant, which is now applied in combination.

As regards the motivation to combine elements for different references, a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see *In re Sovish* 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)); further, references may be combined although none of them explicitly suggests combining one with the other (see *In re Nilssen* 7 USPQ2d 1500 (Fed. Cir. 1989)). It has long been the law that the motivation to combine need not be found in prior art references, but equally can be found "in the knowledge generally available to one of ordinary skill in the art." *In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (citing *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988)). The motivation to combine can be found either in a prior art reference, or it can be implicit in the knowledge of one of ordinary skill in the art. See *In re Huston*, 308 F.3d 1267, 1280 (Fed. Cir. 2002); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 (Fed. Cir. 1997).

Sources suggesting a combination may be: (1) the combined teachings of the prior art, (2) the knowledge of the ordinary practitioner and (3) the nature of the problem to be solved. "The test for implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000).

In *Richard Ruiz and Foundation Anchoring Systems, Inc. v. A.B. Chance Company*, No. 03-1333 (Fed. Cir. January 29, 2004), the court emphasized that an "express written teaching in the art" to combine references was not required [emphasis added]. Rather, motivation may come from "the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem."

An argument that there is no teaching, suggestion or motivation to make a combination or modification is not at all sufficient on its own to show non-obviousness. See *KSR International Co. v. Teleflex Inc.*, 550 U.S. --, 82 USPQ2d 1385 (2007).

Please further note the following from Section 2144 of the MPEP: "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent...The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem...It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant." Also Chief Judge Nies writes in a concurring opinion, "While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or the prior art specifically suggest making the combination...In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference". See *In re Oetiker* 977 F.2d 1443, 24 USPQ.2d 1443 (Fed.Cir.1992).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry specifically concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 571-272-6701.

Any inquiries of a general nature or relating to the status of this application may be made through either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A response to this action should be mailed to:

Mail Stop _____
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450,

Or faxed to:

PTO Central Fax: 571-273-8300

F. VANAMAN
Primary Examiner
Art Unit 3618

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